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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,933	09/09/2003	Sunny E.L. Huang	7342	1592

7590

07/12/2005

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EXAMINER

REIS, TRAVIS M

ART UNIT PAPER NUMBER

2859

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/657,933	HUANG, SUNNY E.L.	
	Examiner	Art Unit	
	Travis M. Reis	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005 & phone interview on 7/6/5.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

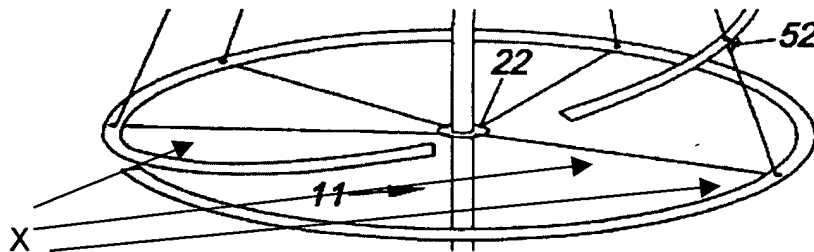
Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (U.S. Patent 6048590) in view of Headley (U.S. Patent 6164304), Byers (U.S. Patent 613063), Shu (U.S. Patent 6109764) & Shoemaker (U.S. Patent 3132624).

With reference to claims 1, 2, & 10, Phillips discloses a resiliently expandable structure (10) in the shape of a cone comprising a structure (13), having an inherent spiral configuration formed of a band of resilient polymer material (Abstract); a base member (22) including wire tethers (X, see below)



having a span greater than the largest diameter of said structure and joining said structure at one or more points; a cross brace (21) having a span of the narrowest diameter of said structure, joining said structure at multiple points, and located opposite said base member (Figure 1); and illuminating means (54), regularly arrayed along the length of said band (Figures 1-3).

Phillips does not disclose a polymer strap, one end joining said cross brace & securing temporarily to said base member with an opposite free end, having sufficient length

to span at least the diameter of said structure when collapsed, a width narrower than the width of the base member; cooperating hook and pile fasteners with one segment of said hook and pile located at the fixed end of said strap and a second segment of said hook and pile located at the free end of said strap, whereby said strap extends from said cross brace, wraps the diameter of said structure when contracted, returns to said cross brace, and said second segment secures to said first segment.

Headley discloses an umbrella (10) with a polymer strap (28) of sufficient length to span at least twice the diameter of said structure when collapsed (Figure 3) with cooperating hook and pile fasteners (60a, 60b) with one segment of said hook and pile fasteners located at the fixed end of said strap and a second segment of said hook and pile located at the free end of said strap, whereby said strap extends from an end segment (26), wraps the diameter of said structure when contracted, returns to said end segment, and said second segment secures to said first segment (Figure 3). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the teaching of Headley, i.e.: a polymer strap that wraps around an apparatus to compress said apparatus, and said strap be secured by a hook and pile fastener located on said strap at one end and at midway point; to the cross brace disclosed by Phillip and hence be of a length to span the diameter of the structure and have a width narrower than the base member, in order to better temporarily secure the collapsed structure closed.

Phillips does not disclose said illuminating means are integral to said band.

Bryers discloses an apparatus (10) for arranging decorative lights (82) integrally within bands (30) by frictional fitting into molded openings (96) (Figures 1, 6, 9). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the molded openings disclosed by Bryers to the band disclosed by Phillips in

order to attach illumination means more efficiently than using separate clamps.

Phillips does not disclose said illuminating means are light emitting diodes.

Shu discloses LED lamps for decorative lamp strings (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the lights disclosed by Phillips with the LED lamp string disclosed by Shu in order to be more energy efficient.

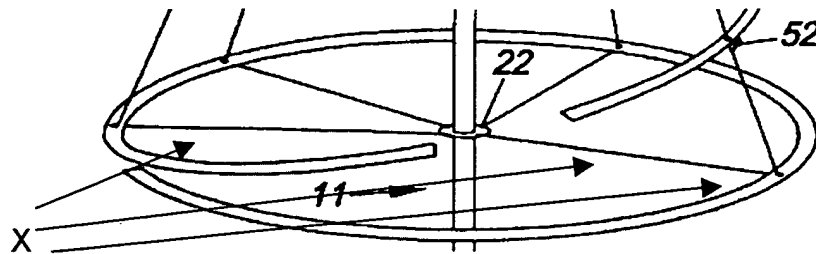
Phillips does not disclose a battery pack connecting to said illuminating means, locating upon said base member, and providing energy for said illuminating means.

Shoemaker discloses a collapsible signal device (30) with a battery pack (45) located upon the base member (23) for providing portable power to illumination means (41). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the battery pack disclosed by Shoemaker to the base member disclosed by Phillips in order to make the apparatus more portable.

With respect to the preamble of the claims 1-3 & 10: the preamble of the claim does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. **Kropa v. Robie**, 88 USPQ 478 (CCPA 1951).

3. Claims 11 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips in view of Say (U.S. Patent 5335622), Byers, Shu, & Shoemaker.

With reference to claims 11 & 12, Phillips discloses a resiliently expandable structure (10) in the shape of a cone comprising a structure (13), having an inherent spiral configuration formed of a band of resilient polymer material (Abstract); a base member (22) with wire tethers



having a span (X, see below) greater than the largest diameter of said structure and joining said structure at one or more points; a cross brace (21) having a span of the narrowest diameter of said structure, joining said structure at multiple points, and located opposite said base member (Figure 1); and illuminating means (54), regularly arrayed along the length of said band (Figures 1-3).

Phillips does not disclose a generally centered fitting having internal threading that cooperates with a external threading of a button cooperating together to releasably secure said structure in a contracted position.

Say discloses an indicator cap embodiment (24) in Figures 3 & 4, external thread/lugs (70) threadably engage the internal thread/lugs (73) in order to sealingly engage the cap to the housing (230) (col. 7 lines 16-25) (Figures 3 & 4). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the cap disclosed by Phillips with the fitting with external thread/lugs and add the button with internal thread/lugs disclosed by Say to sealingly engage the cap to the base.

Phillips does not disclose said illuminating means are integral to said band.

Bryers discloses an apparatus (10) for arranging decorative lights (82) integrally within bands (30) by frictional fitting into molded openings (96) (Figures 1, 6, 9). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the molded openings disclosed by Bryers to the band disclosed by Phillips in order to attach illumination means more efficiently than using separate clamps.

Phillips does not disclose said illuminating means are light emitting diodes.

Shu discloses LED lamps for decorative lamp strings (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the lights disclosed by Phillips with the LED lamp string disclosed by Shu in order to be more energy efficient.

Phillips does not disclose a battery pack connecting to said illuminating means, locating upon said base member, and providing energy for said illuminating means.

Shoemaker discloses a collapsible signal device (30) with a battery pack (45) located upon the base member (23) for providing portable power to illumination means (41). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the battery pack disclosed by Shoemaker to the base member disclosed by Phillips in order to make the apparatus more portable.

With respect to the preamble of the claims 11-13: the preamble of the claim does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Response to Arguments

4. Applicant's arguments with respect to clamps, the Prior Art of Ybanez, the Prior Art of Rahman, cylinders as decorations, the Prior Art of Campbell, & bayonet type locks, have been considered but are moot in view of the new ground(s) of rejection.

5. In response to applicant's arguments that the base member of Phillips is less than the largest diameter of the spiral; these arguments have been fully considered but they are not persuasive since the base member includes the wire tethers and hence has the span of the largest diameter of the spiral, as detailed above in paragraph 2.

6. In response to applicant's arguments that Phillips does not disclose how the cap member secures to the hub; these arguments have been fully considered but they are not persuasive since this limitation is met through the addition of the securing means disclosed by Headley, as detailed above in paragraph 2.

7. In response to applicant's arguments that the present invention makes no claim to electrical polarity or position as Shu does; these arguments have been fully considered but they are not persuasive since these features, or any other of the features of the Shu invention, do not prevent the addition of the LEDs disclosed by Shu to the apparatus disclosed by Phillips, as detailed above in paragraph 2. The lack of features in the applicant's invention does not mean Prior Art with such features are unable to be used in a rejection.

8. In response to applicant's argument that Headley is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem of compressing a conical item securely is sufficient motivation to apply the teaching of Headley to the apparatus of Phillips. In addition, the additional features of Headley, i.e.: completely covering the invention, do not prevent the addition of the strap means teachings of Headley to the apparatus disclosed by Phillips, as detailed above in paragraph 2. The lack of features in the applicant's invention does not mean Prior Art with such features are unable to be used in a rejection.

9. In response to applicant's argument that Say is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in

order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem of securing a cap member temporarily to a base member is sufficient motivation to apply the cap type features disclosed by Say to the cap type disclosed by Phillips, as detailed above in paragraph 3.

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the illumination improvements detailed by the Shu patent, and the securing of a conical device detailed by the Headley & Say patents hold sufficient motivation, detailed in paragraphs 2 & 3 above, to add them to the Phillips invention.

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., used to direct vehicular traffic) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

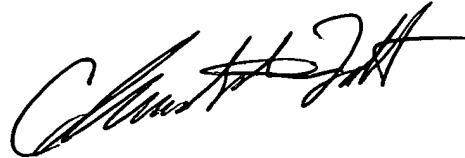
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M. Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F.

Art Unit: 2859

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis
Examiner
Art Unit 2859

tmr
July 7, 2005



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

CHRISTOPHER W. FULTON
PRIMARY EXAMINER